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REMARKS

Applicants appreciate the recognition of patentable subject matter in the present application.

Applicants hereby add new claims 31-34. Accordingly, claims 1-34 are pending in the present application.

Claim 22 is objected to. Claims 1-3, 7, 10-12, 16 and 27 stand rejected under 35 USC 102(b) for anticipation by U.S. Patent No. 6,028,674 to Tognazzini et al. Claims 4 and 13 stand rejected under 35 USC 103(a) for obviousness over Tognazzini in view of U.S. Patent No. 6,035,295 to Klein. Claims 6 and 15 stand rejected under 35 USC 103(a) for obviousness over Tognazzini in view of U.S. Patent No. 6,672,695 to Naka. Claims 8 and 17 stand rejected under 35 USC 103(a) for obviousness over Tognazzini in view of Naka. Claim 19 stands rejected under 35 USC 103(a) for obviousness over Tognazzini in view of Naka. Claims 5, 9, 14, 18 and 23 stand rejected under 35 USC 103(a) for obviousness over Tognazzini in view of Naka. Claims 24, 26 and 30 stand rejected under 35 USC 103(a) for obviousness over Tognazzini in view of U.S. Patent No. 5,706,037 to McIntyre. Claims 22, 25, 28 and 29 stand rejected under 35 USC 103(a) for obviousness over Tognazzini in view of U.S. Patent No. 6,609,212 to Smith.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Referring to the objection to claim 22, Applicants respectfully submit the claim was clear and proper as originally submitted but hereby amend the claim to more positively state comparison of the number of pages of the image job with the predictive data. Accordingly, the claim recites comparing the number of pages of the job with predictive data which is indicative of a remaining supply of the consumable. Claim 22 is clear and understood by one of skill in the art and Applicants respectfully request withdrawal of the objection to claim 22.

Referring to claim 1, Applicants respectfully submit the Office has failed to establish a proper 102 rejection of claim 1 for the reasons set forth in Applicants' previous response as well as the reasons set forth below.

In particular, the Office has improperly reworded the language of the claims to arrive at the anticipation rejection. More specifically, at page 2 of the Action, the Office states that the Tognazzini's teachings of step S450 disclose "indication that the

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consumable used or in use has changed." However, such is irrelevant inasmuch as claim 1 defines *reception of a change of use indication with respect to the consumable* which does not claim changing the consumable. Applicants respectfully refer the Office to the originally-filed specification for proper interpretation of the change of use indication. In particular, Applicants refer the Examiner to paragraph 0033 of the originally filed specification where it is stated that a consumable may be used in different environments which in no way may be interpreted to disclose changing of the consumable itself. Applicants respectfully request interpretation of the claims in accordance with the claim language and originally filed specification which makes clear that the changing the consumable of Tognazzini fails to disclose or suggest the claimed received change in use indication with respect to the consumable as positively claimed. Positively recited limitations of claim 1 are not disclosed nor suggested by the prior art and claim 1 is allowable for at least this reason.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 5, Applicants again assert the Office has failed to establish a proper 103 rejection for at least the reasons set forth in the previous response and the below reasons. More specifically, the Office at pages 4-5 of the Action has again merely reiterated its bald allegations set forth in the previous action and has failed to establish proper motivation to combine the reference teachings. The Office has failed to point to any objective evidence of record that Tognazzini is concerned with moving consumables between printers or with transfer of information regarding a consumable between printers to motivate one to look to Naka for meaningful teachings. The benefit of "the data used associated with the consumable would be known to the new printer" set forth by the Office on page 4 for motivation is irrelevant to the teachings of Tognazzini not concerned with plural printers or movement of consumables between printers. The teachings of Naka are irrelevant to the teachings of Tognazzini since Tognazzini is not concerned with plural printers or exchange of information therebetween, there is absolutely no improvement provided by a modification of Tognazzini pursuant to the teachings of Naka and the Office has failed to establish proper motivation to combine the reference teachings. The mere fact that the printer

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may be located upon a network fails to provide the proper motivation inasmuch as the mere fact that references *can* be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination*. MPEP §2143.01(8th ed., rev. 2) *citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Claim 5 is allowable for at least the above-mentioned compelling reasons.

Referring to claim 7, the Office relies upon step s420 as allegedly teaching the claimed modification of the prediction operations which are allegedly disclosed by steps 440, 460, 610, 620. There are no teachings of record that steps 440, 460, 610, 620 are suspended let alone suspended during the performing of step 420. Limitations of claim 7 are not disclosed nor suggested by the prior art and claim 7 is allowable for at least this reason.

Referring to the rejection of claim 9, the Office has failed to establish proper motivation to combine the reference teachings and claim 9 is allowable. A proper prima facie 103 rejection requires objective evidence of record to support the combination of references as set forth in *In re Lee* discussed in the previous response. Tognazzini is concerned with printing solutions of a single printer and avoiding print quality problems when a consumable has been depleted. Tognazzini is not concerned with systems having plural printers. However, even if Tognazzini is concerned with systems having plural printers, there is no evidence of record that Tognazzini is concerned with moving consumables between printers, that problems with respect to movement would be solved by Naka, or that any other advantages to the system of Tognazzini would result from the combination. The Office has fabricated hypotheticals of Tognazzini being concerned with multiple printer systems and movement of consumables therein to support the combination of reference teachings. However, there is no objective evidence of record to support the combination and the 103 rejection is improper for at least this reason.

Referring to claim 22, the Office baldly alleges on page 16 of the Action that the combination of Smith with Tognazzini is proper to allow more accurate predictions of the ability to print jobs. However, there is no evidence of record to support the bald allegations that accuracy would be improved. Further, Tognazzini already discloses incrementing the counter corresponding to the number of pages or copies and there is no evidence that any improvements result from the combination of the references

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compared with the references taken individually. Applicants respectfully submit the Office has failed to establish proper motivation for combining the reference teachings for at least these reasons.

In addition, Tognazzini does not analyze a print job at steps 460 or 470, or at Fig. 6 but merely analyzes data of already imaged jobs. Tognazzini is not arranged to account for any analysis of a job before it is imaged or "to be imaged" as claimed and Tognazzini would require substantial modification changing the principle operation of Tognazzini to operate in a manner defined in claim 22. However, the court in *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) reversed a PTO 103 rejection because the suggested combination of references would require a substantial reconstruction and redesign of the elements shown in the primary reference as well as a change in the basic principle under which the primary reference construction was designed to operate. There is no benefit to the system of Tognazzini to motivate one to make the substantial modifications necessary to accommodate the Smith teachings. There is no evidence of record to support the bald allegation that "more accurate prediction" would be provided by the combination as baldly alleged by the Office. The 103 rejection of claim 22 is faulty for the above reasons and Applicants respectfully request allowance of claim 22.

Referring to claim 23, Tognazzini is not concerned with systems having plural printers or movements of consumables between printers. There is no motivation to modify the teachings of Tognazzini pursuant to the teachings of Naka regarding plural printers and the 103 rejection is improper for at least this reason. Furthermore, even if the teachings of the references are combined, the combination fails to disclose or suggest the change of use indication is responsive to the change in environment from a *first type of printing environment* to a *second type of printing environment* different than the first type of printing environment. Accordingly, limitations of claim 23 are not disclosed even if the teachings of Naka are combined with Tognazzini and the Office has failed to establish a proper prima facie 103 rejection for this additional reason and claim 23 is allowable.

Referring to claim 24, Tognazzini discloses incrementing a counter at step S440. Significant modification to Tognazzini would be required to accommodate the teachings of McIntyre and the 103 rejection is improper in view of the *Ratti* authority. Furthermore, the Office on page 15 baldly alleges that the combination is appropriate in

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order to print as many pages as possible for the user as well as not wasting any toner by replacing it before it was completely out. Applicants submit the motivational rationale is insufficient. In particular, Tognazzini already discloses double/triple printing when the ink gets low. Accordingly, Tognazzini already discloses a thorough system for fully using a consumable, not wasting a consumable and printing as many pages as possible and the teachings of McIntyre are redundant to Tognazzini. There are no problems of Tognazzini cured by McIntyre and no evidence exists that other improvements to Tognazzini would result from the combination. There is no motivation to combine the teachings and the 103 rejection is improper for at least this reason.

Referring to claim 25, there is no benefit to the system of Tognazzini by modification per the teachings of Smith to motivate one to make the substantial modifications necessary to accommodate the Smith teachings. There is no evidence of record to support the bald allegation that "more accurate prediction" would be provided as alleged by the Office. There is no motivation in support of the 103 rejection and Applicants respectfully request allowance of claim 25.

Referring to claim 26, Tognazzini analysis of steps S460 and S470 is not disclosed as being performed responsive to provision of an image job for imaging. To the contrary, Tognazzini is clear that all analysis occurs after a job is imaged by steps S460 and S470 where the job has been previously imaged and the counter incremented. The Office has failed to demonstrate by objective evidence that there any improvements result or that any problem would be resolved by the combination of the reference teachings to motivation one to combine the prior art teachings. There is no evidence in support of Tognazzini experiencing issues with respect to processing time or that processing time would be saved if the references are combined as baldly alleged by the Office. Furthermore, Tognazzini discloses warning indicator 660, warning light 665, audible alarm 666, printed warning 667 and notification of maintenance 650. Accordingly, Tognazzini already discloses adequate warnings and even automatic change of a cartridge at step 680 and there is no evidence of record that the warnings are deficient or that any improvement would result from the combination with McIntyre as baldly alleged at pages 15-16 of the Action. Claim 26 is allowable for the above-mentioned reasons.

Referring to independent claim 10, changing a consumable fails to disclose or suggest indicating a change of use of a consumable as positively claimed. Positively

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recited limitations of claim 10 are not disclosed nor suggested by the prior art and claim 10 is allowable for at least this reason.

The claims which depend from independent claim 10 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Applicants hereby add new claims 31-34 which are supported at least by Figs 3A-3B and the associated specification teachings of the originally filed application.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

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By:

  
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